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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,427	12/27/2001	Joseph C. Kawan	CITI0241	1686
27510	7590	08/30/2005	EXAMINER	
KILPATRICK STOCKTON LLP			CHEUNG, MARY DA ZHI WANG	
607 14TH STREET, N.W.			ART UNIT	
WASHINGTON, DC 20005			PAPER NUMBER	

3621

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/034,427

Applicant(s)

KAWAN ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 and 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the amendment filed on June 17, 2005. Claims 1-24 are pending. Claims 1-12 and 20 are examined. Claims 13-19 and 21-24 are withdrawn and will not be examined. Claims 1 and 20 are amended.

### ***Response to Arguments***

2. Applicant's arguments filed June 17, 2005 have been fully considered but they are not persuasive.

The applicant's arguments are all based on belief of Foster (U. S. Patent 6,332,134) fails to teach the amended limitation "receiving, by the financial institution, a user-initiated request from a merchant for settlement of a network transaction with the merchant". Examiner respectfully disagrees because in an alternative embodiment Foster clearly teaches the financial institution receives a user-initiated request from a merchant for transaction settlement (see Figs. 8-9).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4-5, 8-11 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Foster, U. S. Patent 6,332,134.

As to claim 1, Foster teaches a method for facilitating a secure financial transaction for a user over an open network, comprising (abstract):

- a) storing a payment preference profile for the user consisting at least in part of a designation of at least one user account for settlement of network transactions for the user on a customer payment options profile and authentication information database of a financial institution (column 4 lines 57-59 and column 5 lines 5-44 and Fig. 2; *specifically, "payment preference profile" corresponds to the information such as account number in Foster's teaching, and "authentication information database" corresponds to the card company's records that comprise user's ID and password*);
- b) receiving, by the financial institution, a user-initiated request from a merchant for settlement of a network transaction with a merchant (column 12 lines 17-59 and Figs. 8-9);
- c) accessing a customer authentication and authorization server by the financial institution in regard to the user (column 5 lines 32-34 and column 12 line 17 – column 13 line 4 and column 16 lines 37-52 and Figs. 8-9);
- d) securely accessing the user's payment preference profile on the customer payment options profile and authentication information database by the customer authentication and authorization server to identify the user account designated for settlement of network transactions for the user (column 5 lines 32-34 and column 12 line 17 – column 13 line 4 and column 16 lines 37-52 and Figs. 8-9);

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e) initiating settlement of the network transaction with the designated account by a deal closing server of the financial institution, if the user-initiated request for settlement is authenticated and authorized by the customer authentication and authorization server (column 12 line 17 – column 13 line 9 and Figs. 8-9);

f) notifying the merchant of payment and confirming completion of settlement of the network transaction to the user by the deal closing server (column 12 line 17 – column 13 line 9 and Figs. 8-9).

As to claim 2, Foster teaches storing the payment preference profile for the user further comprises storing other preferences and rules for the user instructing the user's financial institution in handling network-negotiated transactions for the user (column 12 lines 1-17 and column 14 lines 9-21).

As to claim 4, Foster teaches storing other preferences and rules for the user further comprises storing rules for each user account designated for settlement of network transactions for the user (column 14 lines 9-21).

As to claim 5, Foster teaches storing the payment preference profile for the user further comprises allowing the user to update the payment preference profile through at least one of the Internet through a designated financial institution website server, telephonically through a customer service representative, and through mail (column 6 line 34 – column 7 line 14 and column 10 lines 1-12).

As to claim 8, Foster teaches receiving the user-initiated request by the financial institution further comprises allowing the user to select an alternative payment option 9column 7 lines 11-14 and column 10 lines 1-12).

As to claim 9, Foster teaches receiving the user-initiated request by the financial institution further comprises allowing a browser plug-in of a processor of the user to access the processor and formulate a secure electronic authorization/payment message and send the message back through the browser plug-in to an electronic address for a merchant server (column 1 lines 31-49 and column 6 lines 35-42 and column 7 line 37 – column 8 line 47 and column 12 line 34 – column 13 line 9 and Figs. 1-3, 8-9).

As to claim 10, Foster sending the message back through the browser plug-in to the merchant server further comprises passing the message securely through the merchant server to the deal closing server of the financial institution (column 1 lines 31-49 and column 6 lines 35-42 and column 7 line 37 – column 8 line 47 and column 12 line 34 – column 13 line 9 and Figs. 1-3, 8-9).

As to claim 11, Foster teaches accessing the customer authentication and authorization server by the financial institution according to identifying information for the user securely stored on a processor located at a remote site of the user, wherein the processor comprises a personal computer (column 5 lines 17-34).

As to claim 20, Foster teaches a system for facilitating a secure financial transaction for a user over an open network, comprising (abstract):

- a) a customer payment options profile and authentication information database of a financial institution storing a payment preference profile for

a user consisting at least in part of a designation of at least one user account for settlement of network transactions for the user (column 4 lines 57-59 and column 5 lines 5-44 and column 15 lines 4-8 and Fig. 2; specifically, *"payment preference profile" corresponds to the information such as account number in Foster's teaching, and "authentication information database" corresponds to the card company's records that comprise user's ID and password*);

b) a deal closing server of the financial institution for receiving, by the financial institution, a user-initiated request from a merchant for settlement of a network transaction with a merchant (column 12 lines 17-59 and Figs. 8-9);

c) a customer authentication and authorization server of the financial institution accessible by the deal closing server for securely accessing the user's payment preference profile on the customer payment options profile and authentication information database to identify the user account designated for settlement of network transactions for the user, wherein the deal closing server is adapted to initiate settlement of the network transaction with the designated account, if the user-initiated request for settlement is authenticated and authorized by the customer authentication and authorization server, and wherein the deal closing server is further adapted to notify the merchant of payment and confirm completion of settlement of the network transaction to the user (column 12 line 17 – column 13 line 9 and Figs. 8-9).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foster, U. S. Patent 6,332,134 in view of Steinberg, U. S. Patent 6,618,763.

As to claim 3, Foster teaches storing other preferences and rules for the user instructing the user's financial institution in handling transactions as discussed above. Foster does not specifically teach wherein storing other preferences and rules for the user further comprises storing a hierarchical order in which user accounts designated for settlement of network transactions for the user should be accessed for payment. However, this matter is taught by Steinberg as delivering information in a hierarchical order defined by the user (column 2 line 62 – column 3 line 19 and Figs. 3A-3B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow other preferences and rules in Foster's teaching to be defined in a hierarchical order by the user as taught by Steinberg so that the transactions can be efficiently processed.

7. Claims 6-7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster, U. S. Patent 6,332,134 in view of Davis et al., U. S. Patent 6,282,522.



As to claims 6-7, Foster teaches receiving the user-initiated request by the financial institution further comprises receiving payment settlement information over the open network and the information is securely stored on a processor located at a remote site of the user, wherein the processor comprises a personal computer as discussed above. Foster further teaches using various encryption schemes to provide a secure environment for transactions (column 1 lines 19-29). Foster does not specifically teach receiving the user-initiated request by the financial institution further comprises receiving payment settlement information over the open network from the user protected by a private key issued by the financial institution for electronic messages which the user intends to be viewed by the financial institution. However, this matter is taught by Davis as the information transmitted from the user is protected by an encryption key issued by the payment server and stored in a processor located at a remote site of the user, wherein the processor comprises one of a personal computer and a smart card (column 11 lines 15-67; Fig. 5 and its associated text). It would have been obvious to one of ordinary skill in the art to allow the various encryption schemes in Foster's teaching to include the feature of the payment settlement information received from the user that is protected by a security key issued by the financial institution and stored in remote site of the user for preventing the information from tampering.

As to claim 12, Foster teaches accessing the customer authentication and authorization server according to the identifying information for the user securely stored on the user's computer processor that was programmed by the financial

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institution when the payment preference profile was stored for the user (column 5 lines 17-34 and column 6 lines 25-46). Foster does not specifically teach the user's computer processor is a smart card processor. However, Davis teaches this matter (column 11 lines 27-38 and column 12 lines 1-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the user's computer processor in Foster's teaching to be a smart card processor for expanding the usage environment of Foster, and thus attracting more people to use Foster's teaching.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is

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(571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300	(Official Communications; including After Final Communications labeled "BOX AF")
(571) 273-6705	(Draft Communications)

Mary Cheung  
Primary Examiner  
Art Unit 3621  
August 26, 2005



MARY D. CHEUNG  
PRIMARY EXAMINER